

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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AND INTERFERENCES**

Ex parte FRANCOIS BRUGGER and ANGELIKA STAMPF

MAILED

Appeal No. 2001-2285
Application No. 08/288,415

SEP 25 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before WILLIAM F. SMITH, SCHEINER, and MILLS Administrative Patent Judges,
MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2-15, which are the claims pending in this application.

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Claim 15 is representative of the claims on appeal and reads as follows:

15. An aerosol container system for metering and administering pharmaceutically active aerosols supplied in the form of a suspension, the suspension including a pharmaceutically active agent and a propellant gas free of fluorochlorohydrocarbons, said aerosol container system comprising:

a container for storing the suspension comprising a container wall, the inner portion of said container wall which defines the interior of the container being coated with a plastics coating which inhibits the pharmaceutically active agent in the suspension from depositing thereon, and

a metering valve system for dosing and releasing the suspension comprising a metering chamber and a valve stem, said valve stem capable of being displaced from a first position to a second position,

wherein in the first position the valve stem affords communication between the interior of the container and the metering chamber while simultaneously blocking communication between the metering chamber and the outside of the aerosol container system such that the metering chamber can be filled with a dose of the suspension from the container, and

wherein in the second position the valve stem blocks communication between the interior of the container and the metering chamber while simultaneously affording communication between the metering chamber and the outside of the aerosol container system such that the dose of suspension in the metering chamber can be released from the aerosol container system.

The references relied upon by the examiner are:

Stetz et al. 2,815,889 Dec. 10, 1957

Gennaro et al. (Gennaro), "Aerosols," Remington's Pharmaceutical Sciences, 17th ed., Ch 93, pp. 1670-1677 (1985)

Grounds of Rejection

Claims 2-15 stand rejected under 35 U.S.C. § 103(a) as obvious over Gennaro in view of Stetz.

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DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Examiner's Answer for the examiner's complete reasoning in support of the rejection, and to the appellants' Brief and Reply Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the following determinations.

35 U.S.C. § 103

Claims 2-15 stand rejected under 35 U.S.C. § 103(a) as obvious over Gennaro in view of Stetz.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). An obviousness analysis requires that the prior art both suggest the claimed subject matter and reveals a reasonable

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expectation of success to one reasonably skilled in the art. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

It is the examiner's position that Gennaro discloses aerosol containers having protective coatings with valves. Some examples of the protective coatings described by Gennaro are oleoresin, phenolic, vinyl or epoxy coatings. Answer, page 3. Stetz is relied on for the disclosure of aerosol delivery devices with metering devices analogous to those claimed.

The examiner summarizes (Answer, page 3):

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the "protective coatings" of Gennaro into the Stetz et al. delivery device and obtain the claimed aerosol container. The motivation to incorporate these "protective coatings" is obtained from the fact that "epoxy coatings" (Gennaro) can be employed as "protecting coatings" (Gennaro) in delivery devices analogous to those of Stetz et al.

Appellants essentially argue that the examiner has failed to present a prima facie case of obviousness because the cited references fail to disclose a plastics coating which inhibits the pharmaceutically active agent in the suspension from depositing thereon. Answer, page 5. The appellants argue that Gennaro remains silent as to the selection of coatings that will inhibit the deposition of a pharmaceutically active agent thereon. Appellants suggest that Gennaro offers no indication as to whether such coatings may be used, or are intended to be used, to inhibit deposition of pharmaceutically active agents. Brief, page 5. Appellants further argue that Stetz fails to remedy

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the deficiencies of Gennaro and makes no mention of any coating for the interior of the can. Id.

We agree with the appellants that the examiner has failed to establish a prima facie case of obviousness in the first instance. In response to appellants' argument regarding the deficiencies of Gennaro, the examiner only summarily concludes that the "appellants' argument that Gennaro offers no indication that these coatings can be employed to inhibit pharmaceuticals is not found persuasive." Answer, page 3. The examiner provides no analysis regarding the relevance of appellants' argument.

In our view, the examiner has failed to provide sufficient evidence of each and every element of the claimed invention. In particular, claim 15 requires more than just a plastics coating. Claim 15 requires a "plastics coating which inhibits the pharmaceutically active agent in the suspension from depositing thereon." According to the specification, especially "advantageous materials that may be used for the plastics coating are, for example, polytetrafluoroethylene, widely known as Teflon, and also perfluoroethylenepropylene." Specification, page 2. Both of these coatings provide for inhibition of pharmaceutical deposition.

Appellants argue that "[c]onservatively, the oleoresin, vinyl, or epoxy coatings briefly mentioned by Gennaro embrace thousands of polymers. Gennaro and Stetz do not appreciate the problems associated with the replacement of fluorochlorohydrocarbons with alternative gas propellants. Consequently, nothing in either Gennaro or Stetz, alone or in combination, would have motivated the skilled artisan to select

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polytetrafluoroethylene or perfluoroethylenepropylene as coatings for use in an aerosol can." Brief, page 7.

We agree. A general rule of patent law is that a prior genus does not anticipate a later species. I Chisum, Patents § 3.02[2] (1985); see In re Ruschig, 343 F.2d 965, 145 USPQ 274 (CCPA 1965). If, however, it is possible to derive a class of compounds of lesser scope than the genus disclosed in a prior art reference on the basis of preferences ascertainable from the remainder of the reference, anticipation may be found. e.g., In re Schaumann, 572 F.2d 312, 316, 197 USPQ 5, 9 (C.C.P.A. 1978); In re Petering, 301 F.2d 676, 681, 133 USPQ 275, 279-80 (CCPA 1962).¹ We agree with appellants that the examiner has pointed to no evidence within Gennaro or Stetz indicating that it is possible to derive a class of compounds of lesser scope than the genus disclosed in Gennaro on the basis of preferences ascertainable from the remainder of the reference which would suggest plastics coatings that inhibit pharmaceutical deposition. In other words, Gennaro provides no suggestion of appellants' lesser scope of plastics coatings of the polytetrafluoroethylene or perfluoroethylenepropylene type or similar plastics coatings which would inhibit pharmaceutical deposition, particularly suitable for use in the presence of

¹ We are mindful that the pending rejection is not that of anticipation but obviousness. The examiner, however, relies on Gennaro alone for the disclosure of a plastics coating.

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fluorochlorohydrocarbon propellants. We also find that Stetz fails to overcome this deficiency found in Gennaro.

Claim 2

With respect to claim 2, we additionally find the examiner has not established a prima facie case of obviousness. Claim 2 requires that the plastics coating in the container system is polytetrafluoroethylene or perfluoroethylene-propylene.

The examiner argues, "concerning claim 2, the compounds disclosed by Gennaro would make obvious 'a plastic coating' since they are plastics." Answer, page 4. The examiner has failed to provide any evidence of knowledge in the art of use of a polytetrafluoroethylene or perfluoroethylene-propylene coating in an aerosol container system. Patent examiners, in relying on what they assert to be general knowledge to negate patentability on the ground of obviousness, must articulate that knowledge and place it of record, since examiners are presumed to act from the viewpoint of a person of ordinary skill in the art in finding relevant facts, assessing the significance of prior art, and making the ultimate determination of the obviousness issue. Failure to do so is not consistent with either effective administrative procedure or effective judicial review. Examiners cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which they rely. See In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002). Thus, it is improper to rely on the "common knowledge and common

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sense" of a person of ordinary skill in art to find an invention obvious over a combination of prior art references, since the factual question of motivation to select and combine references is material to patentability, and cannot be resolved on subjective belief and unknown authority. In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002).

In view of the above, the rejection of claim 2 under 35 U.S.C. § 103(a) over Gennaro in view of Stetz is reversed.

CONCLUSION

In view of the above, the rejection of claims 3-15 under 35 U.S.C. § 103(a) as obvious over Gennaro in view of Stetz is reversed. The rejection of claim 2 under 35 U.S.C. § 103(a) as obvious over Gennaro in view of Stetz is reversed.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REVERSED.

William F. Smith

WILLIAM F. SMITH
Administrative Patent Judge

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Toni R. Scheiner

TONI R. SCHEINER
Administrative Patent Judge

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Demetra J. Mills

DEMETRA J. MILLS
Administrative Patent Judge

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Michael W. Glynn
CIBA Geigy Corp.
520 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005

DJM/jlb